



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,926	11/13/2001	Dominic Dough-Ming Cheung	9623.381	5426

56020 7590 12/07/2006

BRINKS HOFER GILSON & LIONE / YAHOO! OVERTURE
P.O. BOX 10395
CHICAGO, IL 60610

EXAMINER

TINKLER, MURIEL S

ART UNIT PAPER NUMBER

3691

DATE MAILED: 12/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/993,926	Applicant(s) CHEUNG ET AL.	
	Examiner Muriel Tinkler	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
 4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 15-22 is/are rejected.
- 7) ☒ Claim(s) 5, 13-15, 21 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date
:7/22/2002,8/19/2002, 8/27/2003, ~~4~~/15/2004, ~~4~~/25/2005, 2/10/2006 .

DETAILED ACTION

This application has been reviewed. The original claims 1-22 are pending.

Objections and rejections are stated below.

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 21 and 22 have been renumbered to 20 and 21.

There are two claims numbered as 13. It is unclear which of the two claims to add/delete. Therefore, both claims marked as 'claim 13' have not been further treated on the merits.

2. Claim 14 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim 13. See MPEP § 608.01(n). Accordingly, the claim 14 has not been further treated on the merits.

It is unclear which of the two claims marked as 'claim 13' are referenced by the claim 14.

3. Claims 5 and 15 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Art Unit: 3691

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 5 states, "if the desired rank for a selected search listing can not be obtained because of the bid cap, increasing a bid amount for the selected search listing so the bid amount does not exceed the bid cap to position the selected search listing at the best attainable rank." There is no difference between the statements in claim 5 and that of claim 1 which disclose: receiving a bid cap for search listings; and, adjusting the bid amount according to the bid cap.

Claim 15 states "all search listings". There is no difference between "all search listings" as stated in claim 15 and "the search listings" as stated in claim 3.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Davis et. al. (US 6,269,361).

Claims 1 and 5 discuss a pay for placement database search system that: stores one or more search listings associated with an advertiser, each including a bid amount; receiving a bid cap for search listings; and, adjusting the bid amount according to the bid cap. Davis discloses in claim 1, a pay for placement database that includes: "a

Art Unit: 3691

plurality of search listings, wherein each search listing is associated with a network location, at least one search term and a modifiable bid"; and "the bid amount corresponding to the money amount that is deducted from an account". Davis discloses in claim 15, "A method of enabling a network information provider to update information relating to a search listing."

Claim 2 discusses, "increasing the respective bids so long as each respective bid does not exceed the bid cap." Claim 2 is dependent on claim 1 which was disclosed based on the discussion(s) above. Davis discloses in claims 20-22: "The method of claim 15, wherein the account record further includes an account balance"; "wherein the account balance is positive"; and, "subtracting the bid amount from the account balance substantially in real time."

Claims 3 and 15 discuss, "receiving a desired rank for the selected search listings... and adjusting the respective bid amounts for the selected search listings according to the desired rank." Claim 3 is dependent on claim 1 which was disclosed based on the discussion(s) above. Davis discloses in the specification on page 19 and lines 45-49, "a 'New Rank' field, in which the advertiser enters the new desired rank position for a search term. After the advertiser requests that the ranks be updated, the system then calculates a new bid price."

Claims 4 and 12 discuss, "if a tie condition makes a desired rank unavailable for a respective search listing, incrementing a bid amount, and leaving a bid the same, for the respective search listing. Claim 4 is dependent on claim 3, which was disclosed based on the discussion(s) above. Davis discloses in claims 17 and 19: 'the search

Art Unit: 3691

listings in the search result list are sorted in order of decreasing bid amount";
"identifying search listings within a search result list having equivalent bid amounts...
sorting the search listings in order from earliest to most recent." As discussed in claims
1 and 3, the user can adjust the bid amounts accordingly.

Claims 6 and 17 discuss, "reducing the bid amount to a minimum bid necessary
to retain the best attainable rank for the selected search listing," and "receiving a
confirmation of the received bid cap." Claim 6 is dependent on claim 4, which was
disclosed based on the discussion(s) above. Davis discloses on page 14 and lines 21-
41, "a selection also appears in menu that permits an advertiser to add money to the
advertiser's account... The executing process then stores the advertiser's default billing
information and displays the default billing information for the advertiser." Davis also
discloses on page 19 and lines 12-15, "The current rank is followed by a column entitles
'Bid to become #1' defined as the bid amount needed to become the highest ranked
search listing for the displayed search term."

Claim 7 discusses, "reducing the respective bid amounts only if the reduced bid
amount exceeds a system minimum bid." Claim 7 is dependent on claim 3, which was
disclosed based on the discussion(s) above. Davis discloses in the specification on
page 5 and lines 50-52, "the unpaid listing are considered to have a bid amount of zero
and are therefore underneath the paid results." Davis also discloses on page 5 and
lines 54-55, "a system and method for enabling the website promoters to influence a
position for a search listing." According to Davis' claim 14, website promoters pay-for-
placement.

Claims 8 and 9 discuss, if an adjusted bid amount for a selected search listing produces no bid/rank change, leaving the bid amount unadjusted only if the bid amount does not exceed the cap." Claims 8 and 9 are dependent on claim 3, which was disclosed based on the discussion(s) above. Davis discloses on page 6 and lines 32-34, "All search listing changes and modifications are processed substantially in real time to support the online competitive bidding process." The change order process only works when the amount of the bid has changed. The "Change Bids" process is also illustrated in Davis, Figure 8. So if the bid amount that was entered was equal to the original amount, the amount will stay the same.

Claim 16 discusses, receiving a desired rank for a displayed page of search listings and adjusting the bid amounts for search listings on the displayed page. Claim 16 was dependent on claim 1, which is disclosed based on the discussion(s) above. Davis states in claim 30, "enabling a website promoters using a computer network to update information relating to a search listing within a search result list generated by a search engine."

Claim 18 discusses, providing a notification after adjusting the respective bid amounts. Claim 18 was dependent on claim 1, which is disclosed based on the discussion(s) above. Davis discloses on page 15 and line 33-40, "Once the advertiser ascertains that the displayed data is correct, the advertiser may click on a "Confirm" button... which adds money to the appropriate account balance, updates the advertiser's billing information, and appends the billing information to the advertiser's payment history.

Claim 19 discusses, "a system comprising: a database configured to store search listings associated with one or more advertisers, each search listing includes a respective bid amount; first program code to produce an advertiser access page; second program code to update one or more listings of the database in response to a desired rank and bid cap received from the advertiser using the advertiser access page." Davis discloses on page 12 and lines 42-44, "each search listing comprises the following information: search term, web site description, URL, bid amount, and a title." Davis also discloses in claim 14, "a search result list generated by an Internet search engine comprising... a database having at least one account record for each of a plurality of advertising web site promoters... the account record including: at least one search-listing... programming code for providing advertising web site promoter with login access... programming code on said computer system for modifying in substantially real time the search listing of an advertising web site promoter upon receiving a request from said advertising web site promoter."

Claim 20 discusses, "the first program code is configured to display a page of search listings associated with an advertiser including a first text box and a second text box for each displayed search listing, the first text box to receive data corresponding to the desired rank for a search listing and the second text box to receive data corresponding to the bid cap for the search listing." Claim 20 was dependent on claim 19, which is disclosed based on the discussion(s) above. Davis discloses in claim 14, "programming code for generating in substantially real time a search result list in response to the search request, the search result list including search listings from the

Art Unit: 3691

accounts on the database, wherein the search term for each search listing in the search result list generates a match with the search request, the search listings in the search result list arranged in an order determined using the bid amounts of the search listings.

Claim 21 discusses, "the first program code is further configured to display a first page fill text box and a second page fill text box, the first page text box to receive data corresponding to the desired rank for all search displayed on the page and the second page fill text box to receive data corresponding to the bid cap for all search listings displayed on the page." Claim 21 is dependent on claim 19, which was disclosed based on the discussion(s) above. Davis discloses on page 18 lines and 66-67 through page 19 and lines 1-7, "bid amounts for every search listing displayed, the rank values, and the bid amount needed to become the highest ranked search listing matching the search term field. Preferably, the system then presents a display of changes at step 850. After the user confirms the changes, the system updates the persistent state by writing the changes to the account in the database."

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of Fraser (US 6560580).

Art Unit: 3691

Claims 10 and 11 discuss, processing a requested rank to a higher requested rank produces a rank change to a rank below an initial rank, leaving the bid amount unadjusted only if the bid amount required for the initial rank does not exceed the bid cap. Claim 10 is dependent on claim 3, which was disclosed based on the discussion(s) above. Davis discloses the information in claim 3. Davis does not disclose leaving a bid amount unadjusted if a request for a change to a higher rank produces a rank below initial rank. Fraser teaches on page 17 and lines 31-33, "This invention preferably provides ways for the broker to effectively "undo" a trade, either by canceling a pending order, or rolling-back executions during a trade state." Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Davis as taught by Fraser by canceling a change that resulted in a rank below the intended rank if funds are available for the initial rank.



HANI M. KAZIMI
PRIMARY EXAMINER